

Amendment Under 37 C.F.R. § 1.116
U.S. Application No. 09/988,277

Attorney Docket No. Q66911
Art Unit 2834

REMARKS

Claims 1-13 have been examined. Claims 1-13 are all the claims pending in the application.

Response to Arguments

Applicants respectfully thank the Examiner for addressing Applicants' arguments set forth in Applicants' Amendment under 37 C.F.R. § 1.111, filed June 14, 2002 (hereinafter Amendment). However, Applicants respectfully note the following.

The Examiner alleges that Applicants argued that U.S. Patent No. 5,994,807 (hereinafter Coles) does not disclose a bracket. This allegation is incorrect. Page 5, first full paragraph of Applicants' Amendment states that the Examiner failed to identify a bracket in Coles which corresponds to the bracket of claim 1.

Additionally, the Examiner's response failed to appropriately address Applicants' arguments relating to a motivation and suggestion to combine or modify Coles, in view of U.S. Patent No. 5,770,902 (hereinafter Batten). Applicants argued that the Examiner relied on column 2, lines 30-35 of Batten which states that the "primary objective of the present invention is to provide a termination board for a brushless DC motor which reduces the number of interconnections between the motor windings, the electronic control of the motor, the power leads, and the electronic components in the motor." (emphasis added).

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In view of this passage, Applicants argued that the grounds of rejection fail to support the proposed combination because the above-mentioned passage is directed towards a termination board 30, not the allegedly corresponding Hall effect sensors 26 and bracket 28 of Batten, which the Examiner had identified for combination.

Interestingly, the Examiner provides a different reason to support the alleged suggestion or motivation, to modify Coles or combine reference teachings. The Examiner alleges that the sensor is provided to continuously detect the position of the rotor. The Examiner further alleges that the rotor in Coles needs to have a position detection means since the rotor is what determines the direction and force in which the steering system will operate.

Assuming *arguendo*, that one skilled in the art would have been motivated to introduce sensors with the motor of Coles. The Examiner still has yet to provide a reason why one skilled in the art would have been motivated to select annular holder 28 of Batten for combination. Put another way, the Examiner has failed to provide a reason why a skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.

"There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination." MPEP §2143 (8th Edition)(Basic Requirements of a Prima Facie Case of Obviousness) In re Oetiker, 977 F.2d 1443, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In view of the above, the Examiner has failed to establish a *prima facie* case.

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Further, since the Examiner has introduced a new grounds of rejection (motivation to combine), and since said new grounds of rejection was "neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement," it is improper that a final rejection has been issued. MPEP §706.07(a) (Final Rejection, When Proper on Second Action)(8th Edition).

Rejection of Claims 1-3 and 12 under 35 U.S.C. § 103(a) - Coles and Batten

The Examiner has rejected claims 1-3 and 12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Coles, in view of Batten. Applicants respectfully traverse this rejection.

The Examiner has acknowledged that Coles fails to disclose a rotation sensor. (Page 3, lines 10-15 of the Office action). However, the Examiner alleges that Batten cures the deficiencies of Coles. (Page 4 of the Office action).

Applicants have amended claim 1 to further clarify the type and position of the rotation sensor of claim 1. Claim 1 now recites "said rotation sensor of the resolver type comprising a rotor fixedly mounted on said shaft and a stator arranged on the periphery of said rotor."

Batten fails to teach or suggest this aspect of Applicants' motor and rotation sensor. The allegedly corresponding rotation sensor 26 of Batten is entirely different than that claimed by Applicants.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (8th Edition); In re Royka, 490

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F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). The Examiner has failed to establish a *prima facie* case of obviousness because Coles and Batten, individually or in combination, fail to teach or suggest the claimed rotation sensor.

Additionally, as stated above, the Examiner has failed to establish a *prima facie* case of obviousness because one skilled in the art would not have been motivated, at the time of the invention, to have combined or modified Coles and Batten, in the manner suggested by the Examiner.

For at least these reasons, Applicants respectfully request that the rejection of base claim 1 and dependent claims 2, 3 and 12 under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claims 4, 5 and 11 under 35 U.S.C. § 103(a) - Coles, Batten and Yamada

The Examiner has rejected claims 4, 5 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Coles, in view of Batten as applied to claim 3, and in further view of Yamada (U.S. Patent No. 5,801,465; hereinafter Yamada). Applicants respectfully traverse this rejection.

Yamada fails to cure the deficiencies of Coles and Batten as applied to claim 1. Yamada is silent as to rotation sensors. Coles, Batten and Yamada, individually or in combination, fail to teach or suggest the motor of claim 1 that includes the rotation sensor.

Claims 4, 5 and 11 should be patentable at least by virtue of their dependency as well as reciting their own patentably distinct features. For at least these reasons, Applicants respectfully request that the rejection of claims 4, 5 and 11 under 35 U.S.C. § 103(a) be withdrawn.

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Rejection of Claims 6-10 under 35 U.S.C. § 103(a) - Coles, Batten and Hirose

The Examiner has rejected claims 6-10 under 35 U.S.C. § 103(a) as being unpatentable over Coles, in view of Batten as applied to claim 1, and in further view of Hirose et al. (U.S. Patent No. 5,793,132; hereinafter Hirose). Applicants respectfully traverse this rejection.

Hirose fails to cure the deficiencies of Coles and Batten as applied to claim 1. Hirose is silent as to rotation sensors. Coles, Batten and Hirose, individually or in combination, fail to teach or suggest the motor of claim 1 that includes the rotation sensor.

Claims 6-10 should be patentable at least by virtue of their dependency as well as reciting their own patentably distinct features. For at least these reasons, Applicants respectfully request that the rejection of claims 6-10 under 35 U.S.C. § 103(a) be withdrawn.

Rejection of Claim 13 under 35 U.S.C. § 103(a) - Coles, Batten and Chestnut

The Examiner has rejected claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Coles, in view of Batten as applied to claim 2, and in further view of Chestnut et al. (U.S. Patent No. 3,558,940; hereinafter Chestnut). Applicants respectfully traverse this rejection.

Chestnut fails to cure the deficiencies of Coles and Batten as applied to claim 1. Chestnut is silent as to rotation sensors. Coles, Batten and Chestnut, individually or in combination, fail to teach or suggest the motor of claim 1 that includes the rotation sensor.

FROM SUGHRUE MION PLLC DC

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Claim 13 should be patentable at least by virtue of its dependency as well as reciting its own patentably distinct features. For at least these reasons, Applicants respectfully request that the rejection of claim 13 under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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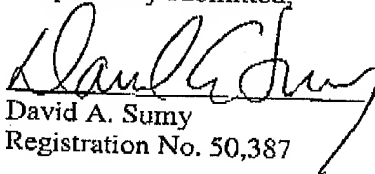


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PATENT TRADEMARK OFFICE

Date: February 26, 2003

Respectfully submitted,


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APPENDIX

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

The claim is amended as follows:

1. (Amended) A motor for use with a motorized power steering apparatus in which said motor is fixedly secured to a housing having a gear accommodated therein for transmitting a torque of said motor to a steering wheel, said motor comprising:
 - a frame of a bottomed cylindrical shape having an opening formed therein;
 - a bracket fixed to said opening in said frame;
 - a rotating element extending through said bracket and having a shaft rotatably supported by a frame side bearing fixedly mounted on said frame and a bracket side bearing fixedly mounted on said bracket;
 - a stationary element fixedly attached to said frame at a location around an outer periphery of said rotating element and having a stator winding wound therearound;
 - a rotation sensor provided on said bracket at one side of said bracket side bearing near said housing for detecting a rotational angle of said rotating element, said rotation sensor of the resolver type comprising a rotor fixedly mounted on said shaft and a stator arranged on the periphery of said rotor; and
 - a plurality of sensor signal wires connected with said rotation sensor for supplying and receiving signals to and from said rotation sensor.